REMARKS

This Application has been reviewed carefully in light of the Final Office Action mailed December 17, 2003. Claims 1-14 were pending in the Application. The Examiner finally rejects Claims 1-14. Applicants amend independent Claims 1 and 8. Applicants respectfully request reconsideration and favorable action in this case.

Information Disclosure Statement

In the Information Disclosure Statement filed on November 6, 2000 ("IDS"), Applicants made a bona fide attempt to comply with 37 C.F.R. § 1.98, but inadvertently failed to include copies of the thirteen co-pending applications being disclosed. As requested by the Examiner and pursuant to 37 C.F.R. §1.97(f), Applicants enclose copies of each of the thirteen co-pending U.S. patent applications disclosed by Applicants in the IDS. Pursuant to 37 C.F.R. §§1.97(g) and (h), Applicants make no representation that these documents qualify as prior art or that these documents are material to patentability of the present application or that a search has been made. Applicants respectfully request the Examiner to consider the IDS pursuant to 37 C.F.R. §1.97(f).

Claim Rejections – 35 U.S.C. §112

The Examiner rejects Claims 1-14 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as their invention. Applicants respectfully submit that the §112 rejection of Claims 1 and 8 is obviated due to Applicants' amendments of these Claims. The Examiner rejects Claims 2-7 and 9-14 under §112 for being dependent on Claims 1 and 8 respectively, which have now been amended to overcome the rejection. Applicants therefore respectfully request the Examiner to withdraw the §112 rejection of Claims 1-14.

Claim Rejections – 35 U.S.C. §102

The Examiner rejects Claims 1-3, 6, 8-10, and 13 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,848,198, which issued to Penn ("*Penn*"). To anticipate a claim, a single prior art reference must describe, either expressly or inherently, each and

every element of the claim. *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987); M.P.E.P. §2131.

Applicants' Claim 1, as amended, recites:

> A method, comprising the steps of:
>
> providing a set of predetermined function definitions; and
>
> preparing a project definition, said project definition including:
>
> a plurality of function portions which each correspond to one of said function definitions in said set, and which each define at least one input port and at least one output port that are functionally related according to the corresponding function definition, one of said function portions also defining a control port which is functionally related to said input and output ports thereof according to the corresponding function definition, said one function portion being configured to process image information according to the corresponding function definition in a manner which varies under control of information at said control port;
>
> a further portion which includes a source portion identifying a data source and defining an output port through which data from the data source can be produced, and which includes a destination portion identifying a data destination and defining an input port through which data can be supplied to the data destination;
>
> information which includes a definition of control information for said control port of said one function portion; and
>
> binding information which includes binding portions that each associate a respective said input port with one of said output ports;
>
> wherein said preparing step includes the step of preparing said one function portion for inclusion in said project definition by permitting interactive user adjustment of working information which will become said control information, while simultaneously displaying a sample image processed according to the function definition corresponding to said one function portion as characterized by the current state of the working information.

Applicants respectfully submit that *Penn* fails to disclose numerous elements of this Claim. In general, *Penn* discloses using fractal mathematics for diagnostic and analytical purposes. More specifically, *Penn* teaches using fractal mathematics to detect, identify, and analyze anomalies and abnormalities within images such as X-rays.

Among other aspects of Claim 1, *Penn* fails to disclose

> preparing said one function portion for inclusion in said project definition by permitting interactive user adjustment of working information which will become said control information, while simultaneously displaying a sample image processed according to the function definition corresponding to said one function portion as characterized by the current state of the working information.

As teaching these elements, the Examiner cites two paragraphs of *Penn*. However, neither paragraph teaches the recited elements. The first paragraph states that a computer is responsive to operator inputs into a keyboard and provides examples of data that a memory can store. *Penn*, Col. 19, lines 10-17. The second paragraph discusses the fact that the computer is coupled to a printer, a Cathode Ray Tube (CRT), and a transmitter, all of which can output scanned images. *Penn*, Col. 19, lines 31-43. These paragraphs merely show that a computer can use various devices to output scanned images. Thus, *Penn* nowhere discloses, in these paragraphs or elsewhere, "preparing said one function portion for inclusion in said project definition by permitting interactive user adjustment of working information which will become said control information, while simultaneously displaying a sample image processed according to the function definition corresponding to said one function portion as characterized by the current state of the working information."

Penn also fails to disclose "binding information which includes binding portions that each associate a respective said input port with one of said output ports." As teaching these elements, the Examiner cites *Penn*'s statement regarding "a header containing descriptive information for the particular image." Col. 19, lines 5-9. However, this in no way shows "binding information which includes binding portions that each associate a respective said input port with one of said output ports."

Furthermore, Applicants reiterate that *Penn* fails to disclose "information which includes a definition of control information for said control port of said one function portion." In response to the Applicant's previously submitted arguments, the Examiner cites various sections of *Penn*. However, none of these sections, nor the previously cited section of *Penn*, show the claimed elements. *See* Col. 11, lines 37-44 (discussing modeling pictures using line segments); Col. 3, lines 27-38 (discussing deriving images from related images); Col. 7, lines 8-25 (discussing steps used to model binary images); and Col. 9, lines 11-17 (discussing using affine transformation values to generat a boundary in a binary image).

These reasons apply similarly with respect to Applicants' Claim 8. Claims 3 and 6 and 9, 10, and 13 depend from Claims 1 and 8 respectively. Therefore, at least for all of the reasons discussed above, Applicants respectfully request reconsideration and withdrawal of the §102 rejections of Claims 1-3, 6, 8-10, and 13.

Claim Rejections – 35 U.S.C. §103

Claims 4, 5, 11, and 12

The Examiner rejects Claims 4, 5, 11, and 12 under 35 U.S.C. §103(a) as being unpatentable over *Penn* in view of U.S. Patent No. 6,130,676, which issued to Wise et al. ("*Wise*"). These Claims depend from Claims 1 and 8 respectively, which are shown above to be patentable over *Penn*. The introduction of *Wise* fails to provide the elements of Applicants' Claims 1 and 8 not shown by *Penn*.

Additionally, Applicants submit that the there is no teaching, suggestion, or motivation to combine or modify the teachings of *Penn* and *Wise* either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art." M.P.E.P. § 2143.01. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." *Id.* (emphasis in original). Thus, the mere fact that the teachings of one reference would improve the teachings of another reference, as the Examiner asserts, does not provide the required suggestion to combine. Furthermore, nothing in *Penn* or *Wise* suggests or motivates the proposed combination, nor has the Examiner provided evidence that suggests the proposed combination. Speculation in hindsight that it would have been obvious to make the proposed combination because the proposed combination would be helpful is insufficient under the M.P.E.P.[1] and governing Federal Circuit case law.[2]

[1] *See* M.P.E.P. § 2145 X.C. ("The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.").

[2] For example, in *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999), the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that evidence of a suggestion,

Thus, for at least these reasons, Applicants respectfully request reconsideration and withdrawal of the §103 rejection of Claims 4, 5, 11, and 12.

Claims 7 and 14

The Examiner rejects Claims 7 and 14 under 35 U.S.C. §103(a) as being unpatentable over *Penn* in view of U.S. Patent No. 5,481,668, which issued to Marcus ("*Marcus*"). These Claims depend from Claims 1 and 8 respectively, which are shown above to be patentable over *Penn*. The introduction of *Marcus* fails to provide the elements of Applicants' Claims 1 and 8 not shown by *Penn*. Additionally, for analogous reasons as discussed above with regard to *Penn* and *Wise*, Applicants submit that the there is no teaching, suggestion, or motivation to combine or modify the teachings of *Penn* and *Marcus* either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Thus, for at least these reasons, Applicants respectfully request reconsideration and withdrawal of the §103 rejection of Claims 7 and 14.

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teaching, or motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant's invention:

> Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence f hindsight.

Id. at 999 (emphasis added) (citations omitted).

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CONCLUSION

Applicants have made an earnest attempt to place the Application in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending claims. If the Examiner feels that a telephone conference or an interview would advance prosecution of the Application in any manner, the undersigned attorney for Applicants stands ready to conduct such a conference at the convenience of the Examiner.

The Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,

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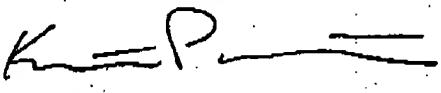
Attorneys for Applicants



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